

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

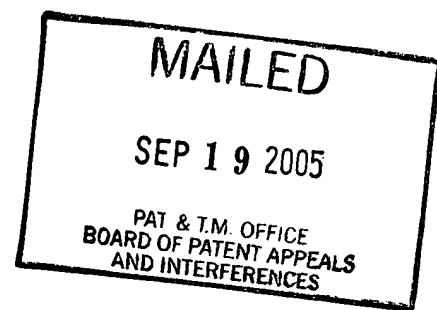
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASATOSHI KUMAGAI,
TOSHIHIRO WATANABE,
KENICHIRO OSADA and
NOBUHIRO MIYATAKE

Appeal No. 2005-2327
Application 09/466,813

ON BRIEF



Before HAIRSTON, OWENS, and NAPPI, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-4, 6-13 and 15-24, which are all of the pending claims. The rejection of claim 7 is withdrawn in the examiner's answer (page 2).

THE INVENTION

The appellants claim an e-mail server, system and method which enables e-mail recipients to refuse advertisements added to the e-mail. Claim 24, which claims the method, is illustrative:

24. A method for enabling a terminal to send a mail, comprising:

receiving a request to add advertisement information to a mail from the terminal by a web server;

sending a predetermined program to the terminal from which the adding request came;

installing the program in the terminal for enabling the terminal to send a recipient addressed mail to a mail server that adds the advertisement information, which is associated with at least one of: (a) user information about a user having the recipient mail address, (b) user information about a user having a sender mail address corresponding to a sender of the mail, and (c) a portion of a message in the mail, to the mail;

storing addition refusal information specifying a mail address of the user that refuses the addition of the advertisement according to an intention of the user; and

stopping the addition of the advertisement information by the advertisement information adding portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail.

THE REFERENCES

| | | |
|----------------------|------------------------|-----------------------|
| Moraes | 6,014,502 | Jan. 11, 2000 |
| | (effective filing date | Apr. 19, 1996) |
| Gough et al. (Gough) | 6,360,221 | Mar. 19, 2002 |
| | | (filed Sep. 21, 1999) |
| Stanbach, Jr. et al. | 6,449,657 | Sep. 10, 2002 |
| (Stanbach) | | (filed Aug. 6, 1999) |

Appeal No. 2005-2327
Application No. 09/466,813

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:
claims 1-4, 6, 8-13 and 15-18 over Stanbach in view of Gough,
claims 19-23 over Stanbach in view of Gough and Moraes, and
claim 24 over Gough in view of Moraes and Stanbach.

OPINION

We reverse the aforementioned rejections.

Each of the appellants' independent claims requires storing addition refusal information specifying a mail address of a recipient that refuses the addition of advertisement information according to an intention of the recipient, and stopping the addition to the mail of the advertisement information by an advertisement information addition portion in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail. For this claim requirement the examiner relies upon column 6, lines 12-39 of Gough (answer, pages 4, 7-8, 11 and 13) which includes the following disclosure:

The advertising supported "free" e-mail can include banner advertisements (of the "click through" type or not), and buttons which provide hyperlinks to advertiser web pages. [col. 6, lines 22-25]

* * *

The advertising may be omitted for paid memberships, although a link to the eSprinkle web site (which is a

form of advertising by the e-mail system host) is likely to be included. [col. 6, lines 32-35]

The examiner argues that "in the system taught by Gough, if it is the intent of the user to refuse advertisements the user can pay for a membership, as in column 6, lines 30-33, and advertisements can be omitted" (answer, page 13).

The portion of Gough relied upon by the examiner discloses that advertisements "may" be omitted. Whether advertisements are omitted is the choice of the e-mail provider, not the mail recipient.¹ If the e-mail provider chooses to include advertisements, Gough does not enable the recipient to refuse the advertisements.

We therefore conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellants' claimed invention.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1-4, 6, 8-13 and 15-18 over Stanbach in view of Gough, claims 19-23 over

¹ The disclosed additional member services provided to users who pay for the e-mail service do not include the ability to refuse advertisements (col. 6, lines 63-67).

'Application No. 09/466,813

REVERSED

BOARD OF PATENT
APPEALS AND
INTERFERENCES

5

Appeal No. 2005-2327

. . Application No. 09/466,813

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